

**ERICSSON** **TELEFAX**REMARKS

Claims 1-13 are currently pending in the present patent application. Reconsideration and allowance of the application is respectfully requested in view of the following remarks.

**Statement of Common Ownership**

The present application was filed after November 29, 1999.

The present application and U.S. Patent No. 6,397,056 (hereinafter called Bugnon) were, at the time the invention of the present application was made, both owned by or subject to an obligation of assignment to Telefonaktiebolaget LM Ericsson, a Swedish corporation, the assignee of the present application.

Therefore, based on post-AIPA, the co-owned U.S. Patent No. 6,397,056 that is cited against claims 1-13 shall not preclude patentability under 35 U.S.C. §103 [35 U.S.C. §103 (c)]. Consequently, in light of the Statement, the U.S. Patent No. 6,397,056 can no longer constitute prior art under 35 U.S.C. §103(a), and the claims 1-13 can no longer be held to be obvious.

**Claim rejections – 35 USC §103**

In paragraph 3 of his report, the Examiner rejected claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,397,056 (hereinafter called Bugnon) in view of U.S. Patent No. 5,668,875 (hereinafter called Brown).

The Invention of claim 1 is a method for handling global challenge authentication registration in a cellular telecommunications network. The method comprises the steps of receiving at a Mobile Switching Center (MSC) a registration message from a mobile station and determining whether or not the MSC has capabilities for bypassing global challenge authentication. If the MSC has capabilities for bypassing global challenge authentication, the method verifies whether or not a Visitor Location Register (VLR) relating to the MSC has a record for the mobile station from which the registration message has been received. If so, the method bypasses the global challenge authentication for the mobile station, else the method performs the global challenge authentication. Furthermore, if the MSC does not have capabilities for bypassing global challenge authentication, the method performs the

**TELEFAX**

global challenge authentication for the mobile station from which the registration message has been received.

Brown relates to a method for authenticating a roaming subscriber unit, which is from a first communication system that uses a first system authentication protocol and which roams in a second communication system that uses a second system authentication protocol. Responsive to a service request or a registration request sent from the subscriber unit, the second communication system sends a challenge a second authentication protocol to the subscriber unit for authenticating the subscriber unit. The subscriber unit further determines that the second authentication protocol is different from the first authentication protocol. Based on that determination the subscriber unit converts the challenge into a format corresponding to the first authentication protocol. The subscriber unit also generates and sends to the second communication system a response compatible with the second authentication protocol. The conversion may also occurs in a home switching center, a visited switching center and location registers (column 6, lines 35-50). Furthermore, the necessary challenges and responses between the subscriber unit and the first and second communication systems are converted in a way to authenticate the subscriber unit in the second communication system.

However, Brown does not teach a method for determining if a MSC is capable of bypassing a global challenge authentication. More particularly, Brown does not disclose a MSC that bypasses a global challenge authentication of a mobile station based on a verification if whether a VLR relating to the MSC has a record for a mobile station. Brown merely describes a method for authenticating a subscriber unit in a visited communication system that uses an authentication protocol different from an authentication protocol used in its home communication system.

Briefly, since Bugnon is disqualified as prior art and therefore cannot constitute prior art under 35 U.S.C. §103(a) and since Brown does not disclose whole or parts of the claimed invention, the combination of Bugnon and U.S. Patent No. 5,668,875 (hereinafter called Brown) cannot render obvious claims 1-13. Also, it can be appreciated that independent claim 8 is a node claim for executing the method of claim 1, which comprises similar limitations as described in claim 1. Thus, claim 8 is believed patentable for the same reasons provided in support of claim 1. Claims 2-7 and 9-13 depend directly or ultimately from claims 1 and 8 while adding further limitations are believed

**ERICSSON** **TELEFAX**

patentable for the same reasons provided in support to claims 1 and 8. For these reasons, Applicant kindly requests withdrawal of the rejection.

In view of the abovementioned remarks, Applicant respectfully requests favourable action for all pending claims.

CONCLUSION

In view of the foregoing, Applicant submits that the present patent application is now in condition for favourable action. Should the Examiner wish to further discuss the present response or patent application, the undersigned can be reached at (514) 345-7891.

Respectfully submitted,

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Page 9 of 9

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